

Remarks/Arguments:

Claims 1-16 are pending in the application.

The title has been objected to as not descriptive, and is amended herewith. No new matter has been added. Accordingly, the applicants respectfully request that the objection be withdrawn.

Claims 1, 2 and 5-8 stand rejected on the ground of non-statutory obviousness-type double patenting as being unpatentable over claims 1-20 of U.S. Patent No. 6,613,922. Claims 11-16 also stand rejected for the same ground based on claims 21-38 of the '922 patent. For the reasons discussed below, the applicants submit that this rejection should be withdrawn and that the pending claims distinguish from the claims of the '922 patent.

First, the applicants note that the assignee listed on the face of the '922 patent is Chirotech Technology Limited. The applicants have confirmed that Chirotech Technology Limited is still the owner of record as of the submission of this Response. Because the present application is owned by Johnson Matthey PLC, the pending application and the cited patent are not commonly owned. Accordingly, a double patenting rejection is not proper.


Moreover, the claims of the present application are distinct from the claims of the '922 patent. In making this rejection, the Examiner has needed to interpret the phrase "substitution group" as any functional group, including H atoms. The applicants submit that this interpretation is overly broad for at least two reasons.

First, the term "substitution" implies that something has been substituted or replaced with something else, i.e., something different. Otherwise, there is no substitution as such. Secondly, and turning the Examiner's attention to the specification, it is stated at page 3, lines 28 and 29 that "substituting groups Z^1 , Z^2 and Z^3 depending upon their number and position **replace** hydrogen atoms on one or both benzene rings of the paracyclophane (I)." (Emphasis added). Accordingly, one of ordinary skill in the art would recognize that "substituting groups" in the claims means groups other than a hydrogen atom. The applicants further point out that the term "substituting group" or "substituent," as used in the organic chemical arts, always refers to a group that replaces a hydrogen atom, and thus the use of such terms in the present application is in agreement with normal usage of those terms.

Based on the Office Action and the Examiner's statement that the Examiner interpreted the phrase "substitution group" as any functional group, including H atoms, it does not appear to be in dispute that the '922 patent describes only paracyclophanes and catalysts where hydrogen atoms are NOT replaced by other groups. Accordingly, the applicants submit that the invention as called for by the pending claims is distinct from the invention as claimed in the '922 patent.

In view of the foregoing amendments and remarks, the applicants respectfully request reconsideration and allowance of the pending claims of this application.

Respectfully submitted,



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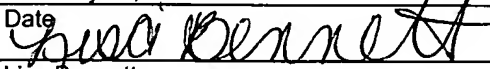
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